



GAU 3726

#15
Reply
Brief
N. Chapman
4-23-99

SKO-104-A-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tojo et al.
Serial Number: 08/627,270
U.S. Filing Date: April 4, 1996
Group Art Unit: 3726
Examiner: J. Gorski
Title: "Method and Machine for Forming
Protective Film on Sprayed Coating
of Large-Sized Product"

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REPLY BRIEF

TECHNOLOGY CENTER 3700

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In connection with the above-identified application, and in reply to the Examiner's Answer (Answer) dated February 16, 1999, please enter the instant Reply Brief pursuant to 37 CFR §1.192(b).

Issues Raised in the Answer

1. At the third paragraph on page 3 of the Answer the Examiner asserts that: applicant's specification states that "forming a protective coating on small parts by coating a strippable paint thereon is ... prior art"; and "[t]hese parts are presumed to be assembled to other parts or have other parts assembled thereto after the coating operation, and presumed to

be stored once coated." The assertions are presented as bases of the rejection of claims under 35 USC §103(a).

Appellant's Response

Upon careful consideration appellant respectfully submits that the Examiner's assertions are not supported by appellant's disclosure, or any other evidence of record, and are not a proper basis for rejection. With reference to the "Description of Relevant Art" at pages 1-4 of the specification, the sole discussion of small parts is the sentence at page 2, lines 7-8, "[w]ith respect to small parts, a strippable paint has been sprayed on them to form a protective film." This is not described as "prior art". On the other hand, while the description at page 2, lines 9-14 of the specification refers to "prior art", such description expressly pertains to a method of coating a vehicle body with a plastic film, not to the small parts being spray coated.

Further, there is no evidentiary, or logical, basis for the asserted presumptions that small parts once coated with strippable paint are assembled to other parts or have other parts assembled thereto after the coating operation. There are no basic accepted principles, of which this Honorable Board might properly take Official Notice, that small coated parts must be assembled to other parts or that the parts must be stored once coated, nor does the Examiner allege personal knowledge (e.g., by way of an examiner's affidavit under 37 CFR §1.107(b)) to support the presumptions. As such the asserted presumptions are not a proper factual basis for rejection under 35 USC §103(a).

2. At the first full paragraph on page 6 of the Answer the Examiner concedes that the "...references may not provide any motivation for applying a strippable paint to an automobile

as an intermediate step in a 'continuous' assembly operation", but asserts that "...the combination of references does provide a motivation for applying strippable paint to parts of an automobile that are to be 'stored' and assembled subsequently."

Appellant's Response

Apart from the improper nature of the Examiner's presumptions regarding small parts, as discussed above, appellant respectfully submits that even if there were a proper factual basis in the prior art establishing that small parts are assembled to other parts after being spray coated with a strippable paint, the Examiner's rejection still fails to establish prima facie obviousness of the claimed invention because the prior art, as a whole, provides no motivation, suggestion or teaching for selectively combining various features thereof in such a manner to achieve the method of claim 1, as proposed by the Examiner. There is no evidence showing that plate-like parts of an automobile (e.g., doors, hood, trunk lid) in Tomioka's vehicle manufacturing process correspond to the "small parts" briefly mentioned in the Background to the invention. There is no specific information regarding the small parts, e.g., the relative size thereof, whether they are painted with a finish coat prior to having strippable paint applied thereto, what the small parts are used for, etc. Without such information there is no apparent analogy between the small parts and the plate-like parts in Tomioka's automobile manufacturing process, which are of a given size, are painted with a finish topcoat (but never with a strippable paint), and are continuously moved along an assembly line in a specific manner during the process.

Moreover, appellant respectfully submits that the specific process disclosed and patented by Tomioka is directly contrary to the method of claim 1. According to claim 1, an

engine and functional parts are mounted to paint-finished automobile *after* the strippable paint is coated on the painted surface of the automobile. In contrast, Tomioka's patented process involves assembly of the plate-like parts (which the Examiner hypothetically equates to the background art "small parts") to the automobile *after* the vehicle body has been fitted out with an engine and functional parts.

3. At pages 4-6 of the Answer, the Examiner defends the rejection of dependent claims 27, 30-33 and 37 as being directed to matters of engineering design choice, despite the advantages of these aspects of the invention discussed in the specification and in appellant's Brief on Appeal, because the claims "fail to provide a nexus" between the subject matter defined therein and the discussed advantages. Essentially, it is the Examiner's position that a no nexus is shown because the claims are broader in scope than the specifically disclosed preferred embodiments of the invention.

Appellant's Response

Upon careful consideration appellant, again, respectfully submits that there is a proper nexus between the advantageous features disclosed in the specification and the limitations of claims 27, 30-33 and 37, and such limitations are not matters of engineering design choice, contrary to the Examiner's assertion. For example, claim 27 defines the preliminary and non-preliminary drying steps in terms of first drying means and second drying means, such that these features are in a means-plus-function format permitted under the last paragraph of 35 USC §112. Correspondingly, these features should be interpreted to include the structure, materials and acts defined in the specification, and equivalents thereof. Thus, the Examiner's comments at the paragraph bridging pages 4-5 of the Answer are not legally accurate.

Further, although the advantages discussed in the specification are primarily applicable to water soluble strippable paints, which are used according to the preferred embodiments of the invention and the specific example disclosed therein, the specification does not indicate that the advantages are *exclusively* achieved with the water soluble strippable paints.

Moreover, it is not otherwise the purpose of the claims to fully or thoroughly define the invention, as the Examiner seems to suggest. Rather, such purpose is achieved by the specification, whereas the purpose of the claims is to patentably distinguish the invention over the prior art. It is appellant's position the present claims are patentably distinct from the prior art of record.

4. At pages 6-7 of the Answer, the Examiner presents eight questions and requests appellant to respond to same, two of which questions were previously presented in the final Office Action (Paper No. 11).

Appellant's Response

The authority/propriety for the Examiner's questions, especially this late in the prosecution, is not apparent to appellant, but to any extent they apply to the duty of disclosure under Rule 56, appellant has provided to the Patent Office all information known by appellant to be material to patentability of the claimed invention. Further, with regard to questions 1-4, the answers thereto are presented in the original application disclosure. Finally, appellant, again notes the existence of US Patents 5,281,436 and 5,428,095 which were cited and applied in parent application USSN 08/398,881, and previously identified in this application because they specifically pertain to the application of strippable paint to automobiles.

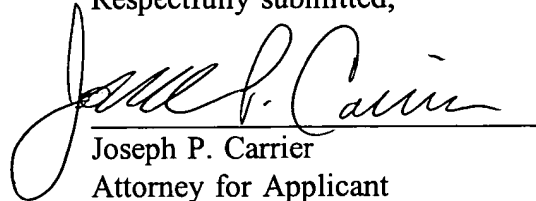
CONCLUSION

Based on all the foregoing comments, as well as those presented in the Brief on Appeal, it is again respectfully submitted that the Examiner has failed to establish prima facie obviousness under 35 USC §103(a) of the methods defined in any of claims on appeal. Correspondingly, applicant respectfully submits that the Examiner's rejection of the claims on appeal is in error, and a reversal of same is respectfully requested.

Favorable consideration and reversal of the final rejection are earnestly solicited.

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April 16, 1999

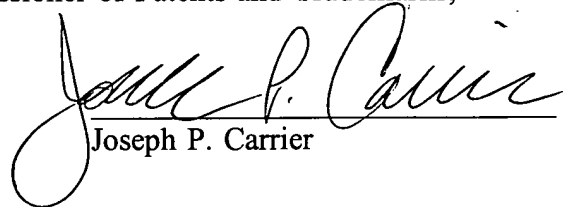
Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231 on April 16, 1999.

Dated: April 16, 1999
JPC/ms



Joseph P. Carrier